

Notice of Allowability

Application No.

09/852,850

Examiner

Sudhaker B. Patel, D.Sc.Tech.

Applicant(s)

UENO ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 10/30/2003.
2. ☒ The allowed claim(s) is/are 1,7,9-12 and 17-25.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/509,778.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: _____.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No. _____.
 - (b) ☐ including changes required by the proposed drawing correction filed _____, which has been approved by the Examiner.
 - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the margin according to 37 CFR 1.121(d).

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|--|
| 1 <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 5 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6 <input checked="" type="checkbox"/> Interview Summary (PTO-413), Paper No. <u>12092003</u> |
| 3 <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No. _____ | 7 <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8 <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9 <input type="checkbox"/> Other |



EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mr. R. Gallagher on 12/9/03.

The application has been amended as follows:

In the amendment paper dated 10/30/2003, in claim 21, line 8 on page 12, please delete [Claims 1,2,and 17] and replace with Claims 1 and 17 .

2. The following is an examiner's statement of reasons for allowance:

3. Applicants' communication paper dated 10/30/2003 is acknowledged. Together with their earlier amendment(s), applicants have cancelled claims 2-6,8,13-16, amended claims 1,7,9,10-12,17, and added new claims 18-25. Therefore, the claims under consideration are the claims 1,7,9-12,17-25, which are renumbered as claims 1-15.

4. This application is a DIV of U.S. Application Sr. No. 09509778, filed 3/31/2000, now U.S.P. 6340759, also RCE of U.S. Application Sr. NO. 09852850, filed 5/11/2001. Applicants have resolved following pending issues.

5. Applicants' amendments to claims as stated earlier, together with their remarks and arguments are sufficient for the withdrawal of rejections made under 35 U.S.C. 112 second paragraph. Therefore, the same are now withdrawn.

6. Applicants have amended claim 11 to recite to recite the step of administering to a patient a pharmaceutically effective dose of the compound of claim 1, its pharmaceutically acceptable salt or hydrates. There for rejections made under 35 U.S.C. 112, first paragraph are now withdrawn.

7. Cancellation of claim 6 has obviated the rejections made under 37 CFR 1.141. Therefore, the rejections are now withdrawn.

8. Applicants' amendments to claims 1,4,9,10,17 have deleted the subject matter overlapping with prior art(s) references Gy et al (NL 8002119), and Th. Karl (FR. 2268524). Thus, the claims in their present form are not anticipated by the references cited. Therefore, the rejections made under 35 U.S.C. 102(b) are now withdrawn.

9. The closest reference(s) prior art(s) of record Aebi et al (CH432808), Nair et al (Chemical Abstract DN 77:"164414), and Simmonds et al (GB 1545767) teach utility and making of compounds with isoquinoline core wherein the 3-position is occupied by amino and 4-position is occupied by -CH₃ groups.

10. The references either alone or in combination do not indicate or suggest to arriving at the instant compounds wherein the instant 3-position of isoquinoline is occupied by a bridge -(CH₂) n-Aryl/Aralkoxy/4-phenylpiperidin-1-yl, 1-position R₂ is piperazine, and the 4-position R₃ is Hydrogen.

11. Therefore, the compounds of instant invention are deemed to be novel and patentably distinct. .

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

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accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sudhaker B. Patel, D.Sc.Tech. whose telephone number is 703 308 4709. The examiner can normally be reached on 6:30 to 5:00 pm (Monday-Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Mukund J. Shah can be reached on 703 308 4716 or Sr. Examiner Mr. Richard Raymond at (703) 308 4523.

The fax phone numbers for the organization where this application or proceeding is assigned are 703 308 4556 for regular communications and 703 308 4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1235.


Sudhaker B. Patel, D.Sc.Tech.
December 8, 2003.


MUKUND SHAH
SUPERVISORY PATENT
EXAMINER
ART UNIT 1624